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PARKHURST & WENDEL SUITE 210 1421 PRINCE STREET ALEXANDRIA, VA 22314			EXAMINER GRUNBERG, ANNE MARIE	
			ART UNIT 1661	PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 041404

Application Number: 09/923,534
Filing Date: August 08, 2001
Appellant(s): NOODELIJK, ROBERT

Charles A. Wendel
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/13/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that there is only one claim and its patentability will be considered by the Board.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Plant Breeder's Right, NL PBR CHR 3164, published 11/16/1999 including Plant Variety descriptors as well as the Plant Breeder's Right Application.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 is rejected under 35 U.S.C. 102(b). This rejection is set forth in a prior Office Action, dated August 25, 2003. The rejection is summarized below.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 (the claim) is rejected under 35 U.S.C. 102(b) as the instant plant 'Etna' was described in the following printed publication more than one year prior to the date of application for Plant Patent (August 08, 2001) in the United States:

NL PBR CHR 3164, filed on October 22, 1999 (published on November 16, 1999), which matured into Grant/Reg. Number 020118 on January 16, 2002;

Applicant has admitted that the instant plant was placed on public sale in the Netherlands in December 1999.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the printed publication, combined with knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant, and said printed publication was published more than one year prior to the date of application in the United States (*In re LeGrice*, 301, F.2d 929, 133 USPQ 365 (CCPA 1962)). If one skilled in the art could have reproduced the plant from a publicly available source, then the publication describing the plant would have an enabling disclosure. See *Ex Parte Thomson*, 24 USPQ2d, 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the

[claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”). See *also* MPEP 2121.03.

It has been determined, and explicitly conceded on the record by applicant, that the above publicly available publication discloses the claimed plant variety and that said claimed variety was placed on public sale in the Netherlands more than one year prior to the filing date of the subject application for United States Plant Patent.

As such, the published application, published and accepted denomination, and published grant relied upon combined with the knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant. Information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art.

A publication relied upon as prior art under 35 U.S.C. 102(b) must be enabling. The text of the relied upon publication standing alone would not have enabled one skilled in the art to practice the claimed invention. When a claim is drawn to a plant, the reference, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant. The admission of prior sale and offer for sale more than one year prior to the filing date of the instant application enables the referenced document because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation. See, *e.g.*, *Thomson*, *supra*. Furthermore, the public was in possession of the plant.

(11) Response to Argument

The Examiner will not comment on a petition from another application especially as it is not made of record in the present case.

The allegation that the published PBR Application is not enabling and thus is not prior art remains unpersuasive. A publication describing a plant does not make the plant available to the public. No matter how detailed the description is one would not be able to reproduce the plant based solely on that description. However, if one skilled in the art, armed with the publication, would have known where to obtain the plant (i.e. from the breeder or assignee) then the plant would have been made and/or used, thus meeting the enablement requirements of 35 USC 112, first paragraph. Applicant's position appears to be that all printed publications are, by definition, non-enabling in the plant art and therefore no rejection can ever be made over a printed publication. This is contrary to what the *LeGrice* Court stated in their decision (*In re LeGrice*, 301, F.2d 929, 133 USPQ 365 (CCPA 1962)).

The Court concluded, "The mere description of the plant is not necessarily an 'enabling' disclosure." 133 USPQ at 378. In the instant application, there is more than a "mere description" of the plant - there is also evidence of public availability of the same more than one year before the instant application was filed. The claimed plant is within the "knowledge of those skilled in the art" by virtue of its public availability. One skilled in the art would thus have known "how to make" the claimed plant upon reading the cited publications, by purchasing a clone of the plant and asexually propagating it by cuttings or any other known method in the art. Thus, the publications provide an enabling disclosure when combined with the knowledge of the skilled artisan.

Applicant cites Donahue in their argument that a PBR application does not qualify as prior art because the text of the document is sufficiently lacking. As noted by Applicant, *In re Donohue* states that disclosure of a claimed invention in a printed

publication will not suffice as prior art if it is not enabling, and that prior art under 35 USC 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention." 226 USPQ at 621.

Donohue teaches that if the reference teaches the invention but does not teach every single inherent property of the invention, it still anticipates the claim. 226 USPQ at 622. The plant of the cited PBR certificate is drawn to the same exact plant as claimed. As a result, the PBR publication teaches each material element of the claim even if the disclosure is not as detailed as an application for plant patent for example.

Applicant argues that the last three of the five elements listed in LeGrice from Robinson on Patents establish that the published PBR application is not proper prior art. The Examiner maintains that the publication is indeed prior art and that it meets the requirements as follows: The PBR was first published 11/16/1999 – more than one year prior to the filing date of 8/8/2001. The PBR is drawn to the same plant as is presently claimed. Finally, the publication is so precise that it is directed to the exact same plant as claimed. No further inventive step is required for one of ordinary skill in the art to be in possession of the invention as it is already in the possession of the public. Again, public availability is cited to show that one of ordinary skill in the art would have been able to make and/or use the invention.

Applicant cites *Elan Pharmaceuticals v. Mayo Foundation*, 346 F.3d 1051 (Fed. Cir. 2003) to support his contention that lacking enablement, the publication is not anticipatory. The Examiner does not disagree and cites the fact that the plant was in the public domain as enabling the publication, thus anticipating the claim.

The second part of Applicant's arguments center on the contention that a sale

abroad is not a patent defeating act and thus is not prior art. This argument has been fully considered but is not persuasive because the rejection is based on a printed publication. The contention that foreign commercial availability or public use is not a bar to patentability under 35 U.S.C. 102(b) is noted but is not relevant. The clear wording of 35 U.S.C. 102(b) is "A person shall be entitled to a patent unless - ...(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States...". There is no geographic limitation of the bar under 35 U.S.C. 102(b) to printed publications in this country. There is no requirement that a printed publication that describes the invention be printed or enabled in this country. The second clause of 35 U.S.C. 102(b) barring public sale or use in this country is not relevant because as noted above, the current rejection under 35 U.S.C. 102(b) is based on foreign published documents ("printed publications"), as enabled by the admitted availability of the plants outside the United States more than one year prior to the date of domestic filing.

Applicant further states that the present situation is not analogous to that in *In re Samour*, 571 F.2d 559, 197 USPQ 1 (CCPA 1978) and *In re Donohue*, 226 USPQ 619 because the PBR does not qualify as prior art as it is non-enabling. Applicant contends that the rejection in *In re Samour* was based on two U.S. patents that were by definition enabling. The Examiner disagrees with this interpretation and notes that the courts refer to a "printed publication" (197 USPQ at 3-4)(226 USPQ at 619, for instance). In accordance with *In re Donohue* and with *In re Samour*, the primary reference discloses every element claimed e.g. the instant plant. Applicant's admission that the plant was for sale was simply cited to show that the plant was in the possession of the public.

Applicant also argues that *Ex parte Thomson*, 24 USPQ2d 1618 (Bd. Pat. App. &

Inter. 1992) does not support the rejection because the case involved a utility application rather than a plant patent application. Applicant further argues that the materials sold in the *Thomson* case were seeds and not plants and that the panel distinguished the case from *In re LeGrice*, 133 USPQ 365 (CPA 1962) based on this distinction. This argument has been carefully considered, however it is not persuasive because *In re LeGrice* as well as 35 USC 161 and 37 CFR 1.161 clearly state that the same rules and laws relating to applications for utility patents also are applicable to patents for plants with the one exception set forth in 35 USC 162. As a result, the standard for anticipation in a plant patent is the same as the standard for anticipation in a utility patent. The means of propagation whether by seed or asexual reproduction is immaterial as prior public use and sale of a plant are the avenues by which a plant enters the public domain. See, e.g., *LeGrice*, 133 USPQ at 370-71. *LeGrice* ruled that a publication alone was not enough to put a plant in the public domain. The fact scenario of this rejection does not parallel the facts in the *LeGrice* case because the rejection here is not based on a publication alone. There was no evidence of public availability of the plant described in the reference publication in *LeGrice*, nor was the issue before the court or addressed by the court in its decision. Just because a publication exists does not mean the publication is enabled. The plant or plant propagatable material must be in the public domain for the publication to be enabled.

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 1661

Respectfully submitted,



Anne Marie Grunberg
April 14, 2004

Conferees



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